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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. |
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| 08/913,811 | 09/24/97 | SUGIHARA | H 356972020100 |

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HM12/0324

EXAMINER

BASKAR, P

| ART UNIT | PAPER NUMBER |
|----------|--------------|
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1641

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DATE MAILED:

03/24/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

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Office Action Summary

Application No.

08913811

Applicant(s)

Sugihara chaf

Examiner

P-Baskar

Group Art Unit

1641

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- ☐ Responsive to communication(s) filed on _____.
- ☐ This action is FINAL.
- ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1-13 ~~1-12~~ is/are pending in the application.
- ☐ Of the above claim(s) 1-11 is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 12-13 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- ☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.
- ☐ received in Application No. (Series Code/Serial Number) _____.
- ☐ received in this national stage application from the International Bureau (PCT Rule 1.7.2(a)).

*Certified copies not received: _____

Attachment(s)

- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s) 4, 6 ☐ Interview Summary, PTO-413
- ☒ Notice of Reference(s) Cited, PTO-892 ☐ Notice of Informal Patent Application, PTO-152
- ☒ Notice of Draftsperson's Patent Drawing Review, PTO-948 ☐ Other _____

Office Action Summary

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DETAILED ACTION

1. Applicant's election with traverse of group III, claims 12 and 13, in Paper No. 8 is acknowledged. The traversal is on the ground (s) the applicant asserts that Invention I-III are linked by the common generic "special technical feature" involves the steps of measuring the physical and chemical properties of the tissue or cell, changing the physical and environment in the environs of the tissue or cell, and then remeasuring the physical and chemical properties of the tissue or cell. This is not found persuasive because the examiner believes that the application has been filed under 35 U.S.C. 371, "Lack of Unity" practice is being followed

Although the applicant's above concept may link the three inventions, such concept does not constitute a "special technical feature" as defined by PCT Rule 13.2 (37CFR1.475(a)). "The expression "special technical features" shall mean those technical features that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art." Specifically US.Patent No 5187096, EPO 585933 and Nisch et al (Biosense.Bioelect 1994, 9:737-741) teach this concept, therefore it does not constitute" a special technical feature" by definition. Therefore, lack of unity is present.. The requirement is still deemed proper and is therefore made FINAL.

2. Claims 1-11 withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected group, the requirement having been traversed in Paper No. 8.

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3. Claims 12-13 are pending in the present application.

4. Claim 12 is rejected under 35 U.S.C. 112 second paragraph as being vague and indefinite for reciting "judging from those two properties whether the added chemical substances, microorganisms or viruses have had an influence on the tissue or cells." It is unclear how measuring electrical and visible properties of the tissue or cells meet the limitations recited in the preamble of testing medicines. The claim recites measuring electrical or visible properties, yet then appears to require judging both properties. Is one and/or both properties necessary?

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 12 and 13 are rejected under 35 U.S.C. 102(b) as being anticipated by Giaever et al (U.S. Patent 5187096).

Giaever et al describes a method which comprises a detector for detecting electrical properties of endothelial cells when chemical substance thrombin is exposed to the cultures in Figure 9 which is observed (i.e visible property). He further describes a testing device that comprises electrical

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measurement portion (i.e visible detection portion) (Figure 3, data acquisition, figure 4, figure 5, figure 6 etc). The prior art anticipates the claimed invention.

7. Claims 12 and 13 are rejected under 35 U.S.C. 102(b) as being anticipated by Nisch et al (Biosense.Bioelect 1994, 9:737-741). Nisch et al describes a method which comprises a detector for detecting electrical properties of neuronal activity in vitro . He measures a detectable electrical signal before and after stimulation in figure 7 which is observed (i.e visible property). He further describes a testing device comprises electrical measurement portion (i.e visible) visible detection portion (Figure 3-monitor, figure 4, figure 5, figure 6 etc). The prior art anticipates the claimed invention.

8. Claims 12 and 13 are rejected under 35 U.S.C. 102(b) as being anticipated by Suzuki et al (U.S.Patent 4288544). Suzuki et al describes a method which comprises a detector for detecting electrical properties of different microorganisms when cultured with different media in Table 1, 2, 3, 4, 5, which is observed (i.e visible property). He further describes a testing device comprises electrical measurement portion (i.e visible) visible detection portion (Figure 1 and 2 potentiometer and recorder). The prior art anticipates the claimed invention.

9. No claims are allowed in the present application.

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10. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file. Applicant has submitted the search report of PCT/JP97/00153. However, these references were not provided. If applicant desires these references to be considered by the examiner, such should be provided as well as form 1449.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Padma Baskar whose telephone number is (703) 308-8886. The examiner can normally be reached on Monday through Friday from 8:30 AM to 4 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jim Housel, can be reached on (703) 308-4027. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-4242.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.

Padma Baskar

3/18/99


NITA MINNIFIELD
PRIMARY EXAMINER